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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/310,073	05/10/1999	GARY R. ACKARET	10980623-1	8322

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/310,073	ACKARET, GARY R.	
	Examiner	Art Unit	
	CESAR B PAULA	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to the response filed on 6/13/02.

This action is made Final.

2. Claims 1-20 are pending in the case. Claims 1, 11, and 18 are independent claims.

Drawings

3. The drawings filed on 5/10/99 have been approved by the draftsperson.

Claim Rejections - 35 USC § 112

4. The rejections of claims 8, and 19 under the first paragraph of 35 U.S.C. 112 have been withdrawn as necessitated by the Applicant's evidence provided in the response filed on 6/13/02.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-2, 4-5, 11-14, and 17-18 remain rejected under 35 U.S.C. 102(e) as being anticipated by Laursen et al, hereinafter Laursen (Pat.# 6,065,120, 5/16/00, filed 12/2/97).

Regarding independent claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). The forms are transmitted using an Internet protocol, such as HTTP.

Claims 2, and 5 are directed towards a computer system for implementing the apparatus found in claim 1, and are therefore similarly rejected.

Regarding claim 4, which depends on claim 1, Laursen discloses a browser capable of the accessing, displaying (rendering) of HTML forms, containing JAVA components (col. 14, lines 40-67).

Claims 11-14, and 17 are directed towards a computer program product on a computer-readable medium for storing the apparatus found in claims 1-2, 1, 1, and 1 respectively, and therefore are similarly rejected.

Claim 18 is directed towards a method for implementing the apparatus found in claim 1, and is similarly rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 7 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Covert et al, hereinafter Covert (Pat. # 6,334,117 B1, 12/25/01, filed on 11/17/98).

Regarding claim 7, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *a Java vending machine operative to pull a user selected Jetsend job.* Covert teaches the obtaining, and controlling of a print job by a Java applet (col.14,lines 12-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Covert, because Covert teaches above a form displaying method for conveniently displaying one question or statement at a time on a PDA.

9. Claims 8, and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Covert, as applied to claim 7 above, and further in view of Laor (Pat. # 6,041,309, 3/21/00, filed on 12/23/98).

Regarding claim 8, which depends on claim 7, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *store a cookie on the web browser of the client machine....detailing a user selected form to be printed and a network address for the output device selected to generate the form.* Laor teaches the storage of a cookie in a client's computer for customizing user's document requests (col.1,lines 27-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, Covert and Laor, because Laor teaches above the

customization of user's requests to align with user's preferences, i.e. device printing the documents.

Claim 19 is directed towards a method for implementing the apparatus found in claim 8, and therefore is similarly rejected.

10. Claim 3 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Wright Jr. hereinafter Wright (Pat. # 5,704,029, 12/30/97).

Regarding claim 3, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *a PDA.* Wright teaches the transferring, displaying (rendering) of a form to a PDA from a computer; the creation of the form takes place at the computer (col.7,lines 1-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Wright, because Wright teaches above a form displaying method for conveniently displaying one question or statement at a time on a PDA.

11. Claims 6, 9-10, 15-16, and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of HP Jetsend Technology Making Device-To-Device Communication Simple, hereinafter Jetsend, http://web.archive.org/web/19980124223300/www.jetsend.com/Backgrnder.html (p.1-6, 1/24/98).

Regarding claim 6, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML

microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *a jetsend capable hard copy output device.* Jetsend teaches the printing of a document using jetsend protocol, and assigning an address to a receiving device (p.1,lines 12-29, and p.2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Jetsend, because Jetsend teaches above the intelligent negotiation of information without user intervention.

Claims 9-10 are directed towards a computer system for implementing the apparatus found in claim 6, and are therefore similarly rejected.

Claims 15-16 are directed towards a computer program product on a computer-readable medium for storing the apparatus found in claim 6, and therefore are similarly rejected.

Claim 20 is directed towards a method for implementing the apparatus found in claim 6, and is similarly rejected.

Response to Arguments

12. Applicant's arguments filed 6/13/02 have been fully considered but they are not persuasive. In response to applicant's arguments regarding claims 1, and 11, the recitation "a form printing apparatus" (p.7,L.7-12, and L.23-27) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 18, the Applicant states that Laursen fails to explicitly teach selecting and printing a form which is stored on a server (p.8,L.5-9). The Examiner disagrees, because Laursen teaches a portable device for outputting or printing HDML forms using Internet protocols such as HTTP or HTTPS (c.15,L.1-52, and fig.6-10 print button).

Claims 2, 4-5, 12-14, and 17 stand rejected at least based upon their dependency, and the rationale above concerning claims 1, and 11.

Regarding claim 7, the Applicant states that Laursen, and Covert fail to explicitly teach or suggest a Java vending machine for pulling a Jetsend Job (p.9,L.1-14). The Examiner disagrees, because Laursen teaches a portable device for outputting or printing HDML forms using Internet protocols such as HTTP or HTTPS (c.15,L.1-52, and fig.6-10 print button). Covert teaches obtaining, and controlling a print job via an HTTP address found in a Java applet (c.14,L.12-67). It would have been obvious to one of ordinary skill in the art to have combined the output and printing taught by Laursen, and the print device control/address via Java applets, because Covert discloses conveniently displaying one question at a time, which would lend itself to the small outputting capabilities of the portable device taught by Laursen.

Regarding claim 19, the Applicant states that Laursen fails to explicitly teach selecting and printing a form which is stored on a server (p.10,L.3-22). The Examiner disagrees, because Laursen teaches a portable device for outputting or printing HDML forms using Internet protocols such as HTTP or HTTPS (c.15,L.1-52, and fig.6-10 print button). Laursen fails to explicitly disclose *store a cookie on the web browser of the client machine....detailing a user selected form to be printed and a network address for the output device selected to generate the form.* Laor teaches the storage of a cookie in a client's computer for customizing user's

document requests (col.1,lines 27-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, Covert and Laor, because Laor teaches above the customization of user's requests to align with user's preferences, i.e. device printing the documents.

Claim 3 stands rejected at least based upon their dependency, and the rationale above concerning claim 1.

Furthermore, and in response to applicant's arguments regarding claim 3, the recitation that Wright teaches away from "forms printing apparatus", and "printed forms" (p.11,L.3-6) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 6, and 9-10 stand rejected at least based upon their dependency, and the rationale above concerning claim 1.

Furthermore, the Applicant states that Jetsend does not cure the deficiencies of Laursen. The Examiner disagrees, because Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52). Laursen fails to explicitly disclose *a jetsend capable hard copy output device.* Jetsend teaches the printing of a document using jetsend protocol, and assigning an address to a receiving device (p.1,lines 12-29, and p.2). It would have been obvious to one of ordinary skill in the art at the

time of the invention to have combined the teachings of Laursen, and Jetsend, because Jetsend teaches above the intelligent negotiation of information without user intervention.

Claims 15, and 20 stand rejected at least based upon their dependency, and the rationale above concerning claims 11, and 18 respectively.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Suzuki et al. (Pat. # **6,298,164**).

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- **(703) 746-7238**, (for **After Final** communications intended for entry)
- **(703) 746-7239**, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- **(703) 746-7240**, (for **Informal or Draft** communications for discussion only, please label "**PROPOSED**" or "**DRAFT**").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CBP

8/21/02

STEPHEN S. HONG
PRIMARY EXAMINER